

**FAX TRANSMISSION****DATE:** April 18, 2003**PTO IDENTIFIER:** Application Number 09/939,011  
Patent Number**Applicant:** James Benn *et al.***FAX RECEIVED**

APR 20 2003

**GROUP 1600****MESSAGE TO:** Examiner Jeffrey Fredman (Group Art Unit: 1637)**FAX NUMBER:** (703) 305-3014**FROM:** Lahive & Cockfield, LLP  
Peter C. Lauro, Esq.**PHONE:** (617) 227-7400**FAX NUMBER:** (617) 742-4214**OFFICIAL****PAGES (Including Cover Sheet):** 6**CONTENTS:**  
1) Transmittal Letter (1 page, *in duplicate*); and  
2) Response to Restriction Requirement (3 pages).

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April 18, 2003

**VIA FACSIMILE**

Commissioner for Patents  
Washington, D.C. 20231

Re: Patent Application Serial No. 09/939,011  
Entitled: *Device Identifying the Presence of a  
Nucleotide Sequence in a DNA Sample*  
Inventors: James Benn *et al.*  
Filed: August 24, 2001  
Group Art Unit: 1637  
Attorney Docket No.: GEN-007ACP

Dear Sir:

I enclose herewith for filing in the above-identified application the following:

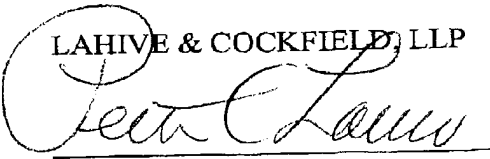
1. Response to Restriction Requirement (3 pages).

Please charge any necessary fees to our Deposit Account No. 12-0080. The undersigned requests any extensions of time necessary to respond. *A duplicate of this sheet is enclosed.*

<b><u>CERTIFICATE OF FACSIMILE TRANSMISSION</u></b>	
I hereby certify that this correspondence is being facsimile transmitted to Commissioner for Patents, Washington, DC 20231 at 703-305-3014 on:	
April 18, 2003	
Date	
Peter C. Lauro, Esq.	Reg. No. 32,360

Respectfully submitted,

LAHIVE & COCKFIELD LLP

  
Peter C. Lauro  
Reg. No. 32,360  
Attorney for Applicants

Date: April 18, 2003

# LAHIVE & COCKFIELD LLP

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April 18, 2003

DUPLICATE

## VIA FACSIMILE

Commissioner for Patents  
Washington, D.C. 20231

Re: Patent Application Serial No. 09/939,011  
Entitled: *Device Identifying the Presence of a  
Nucleotide Sequence in a DNA Sample*  
Inventors: James Benn et al.  
Filed: August 24, 2001  
Group Art Unit: 1637  
Attorney Docket No.: GEN-007ACP

Dear Sir:

I enclose herewith for filing in the above-identified application the following:

1. Response to Restriction Requirement (3 pages).

Please charge any necessary fees to our Deposit Account No. 12-0080. The undersigned requests any extensions of time necessary to respond. A duplicate of this sheet is enclosed.

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April 18, 2003	
Date	
Peter C. Lauro, Esq.	Reg. No. 32,360

Respectfully submitted,

LAHIVE & COCKFIELD, LLP

*Peter C. Lauro*  
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Reg. No. 32,360  
Attorney for Applicants

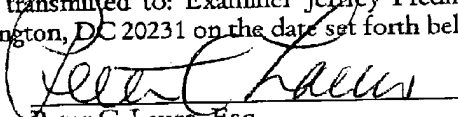
Date: April 18, 2003

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE****In re the application of:** James Benn *et al.***Serial No.:** 09/939,011**Filed:** August 24, 2001**For:** *Device for Identifying the Presence of a Nucleotide Sequence in a DNA Sample***Attorney Docket No.:** GEN-007ACP**Group Art Unit:** 1637**Examiner:** Jeffrey Fredman**VIA FACSIMILE**Commissioner for Patents  
Washington, D.C. 20231**Certificate of Facsimile**

I hereby certify that this correspondence is being facsimile transmitted to: Examiner Jeffrey Fredman, at Facsimile No. 703-305-3014, Commissioner for Patents, Washington, DC 20231 on the date set forth below.

April 18, 2003  
Date of Signature and of Facsimile Transmission

By:

  
Peter C. Lauro, Esq.  
Reg. No. 32,360  
Attorney for Applicants**RESPONSE TO RESTRICTION REQUIREMENT**

Dear Sir:

This is in response to the restriction requirement set forth in the Office Action dated March 20, 2003 (Paper No. 6).

The Examiner has required restriction to one of the following groups under 35 U.S.C. § 121:

- Group I: claims 1-31, (drawn to nucleic acid detection devices, classified in class 435, subclass 287.1); and
- Group II: claim 32 (drawn to methods of nucleic acid detection, classified in class 435, subclass 6).

Applicants are required to elect one of the above groups for prosecution on the merits.

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Group Art Unit: 1637

Attorney Docket No.: GEN-007ACP

Applicants respectfully traverse the requirements for restriction and election, and submit that the requirements are improper. First, Applicants assert that the subject matter of these groups represent different embodiments of a single inventive concept for which a single patent should issue. The pending claims represent an intricate web of knowledge,

continuity of effort, and consequences of a single invention, which merit examination of all of these claims in a single application. More particularly, a single, searchable, unifying aspect, *i.e.*, a flat plate detection cell for detecting of the presence or absence of a sequence in a target DNA sample, links all of the claims.

Moreover, the patent statutes require that Applicants disclose how to make and use the nucleic acid detection system and method of the invention. It is only reasonable, then, that Applicants be allowed to prosecute the system and the method for using the system in a single application. For example, the method of claim 32 specifically recites the use of the *flat plate detection cell*, set forth in the apparatus claims 1-31. Therefore, it is improper to require that the subject matter of these groups be prosecuted in separate patent applications.

Second, Applicants submit that a sufficient search and examination with respect to the subject matter of all claims can be made without serious burden. As the M.P.E.P. states:

[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. M.P.E.P. § 803 (8th ed., Rel. 78A, August 2001).

That is, even if the above-enumerated groups of claims are drawn to distinct inventions, the Examiner must still examine the entire application on the merits because doing so will not result in a serious burden.

Applicants submit that the search and examination of all the claims will have substantial overlap, and no serious burden will result from searching and examining all claims in the same application. This is especially true inasmuch as Groups I and II share the same classification, *i.e.*, class 435 and the flat plate detection cell of claims 1-31 is also recited in claim 32.

In view of this identity of classifications, and the data bases and powerful computer search engines available to the Examiner, there would be no serious burden in examining all the claims in a single application.

Serial No.: 09/939,011  
Attorney Docket No.: GEN-007ACP

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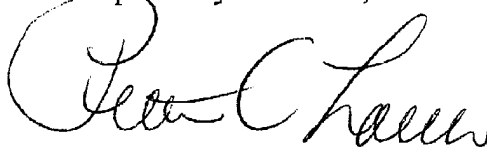
Group Art Unit: 1637

Therefore, in the interest of savings of time and cost to Applicants and the Patent Office, Applicants respectfully request that all the claims be rejoined and searched and examined in a single application.

Nevertheless, in compliance with the directives in the Office Action and in order to expedite prosecution of the instant application, Applicants hereby elect, subject to the foregoing traverse, Group I (claims 1-31).

If a telephone conversation with Applicants' attorney would help expedite the prosecution of the above-identified application, the Examiner is urged to call the undersigned attorney at (617) 227-7400.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Peter C. Lauro".

Peter C. Lauro, Esq.  
Reg. No. 32,360  
Attorney for Applicants

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28 State Street  
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Dated: April 18, 2003